IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

8. H. M

In re Application of

Koichi Ashizawa et al

) Art Unit: 1745

Appln. No.: 09/124,925

) Ex. T. Dove

Filed:

: July 29, 1998

For

: CURRENT COLLECTOR WITH PENETRATING

HOLES OF COMPLICATED SHAPE FOR USE

IN A SECONDARY BATTERY AND

MANUFACTURING PROCESS THEREOF

(AS AMENDED)

RESPONSE

Honorable Commissioner of Parents and Trademarks Washington, D.C. 20231

Sir:

The Notification of Non-Compliance with 37 CFR 1.192(c) (Paper No. 12) has been received.

In the Notification, it is stated that "the brief does not contain a correct copy of the appealed claims as an appendix......," and "The appendix of the appealed claims include the amendments to the claims (filed 12/01/00) filed after the final rejection and not entered by the Examiner."

The amendment to claims 1 and 4 added by the REQUEST FOR RECONSIDERATION WITH AMENDMENT were:

Claim 1: "non-regular" to "complicated"; and

Claim 4: "a given" in line 4 was deleted.

In the Advisory Action, the Examiner stated: "Applicant has amended the claims to include 'complicated' which was previously rejected as being indefinite. Re-adding the term would require the Examiner to reinstate the rejection of claims 1, 2 and 4."

The Examiner also stated: "they [the amendments] raise new issues that would require further consideration and/or search."

Two Observations

(1)

It is not possible for the re-introduction of "complicated" to introduce a "new issue" because it was previously included in claim 1 and rejected. The issue is revisited which cannot, per se, amount to a "new issue" but, in fact to an old issue.

(2)

By stating "...require the examiner to reinstate the rejection of claims 1, 2 and 4" leads, logically, to the conclusion that the old issue is reinstated, and this old issue was addressed in the brief.

What issue is applicant supposed to address in their brief if not one that has been reinstated?

The Notification on Non-Compliance should be withdrawn.

Respectfully submitted,

Felix J D'Ambrosio

Reg. No. 25,721

August 8, 2001

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